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Lowell Train

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Joseph V. MANTESE et al)
) Group Art Unit: 1742
Serial No.:	10/674,245)
)
Filed:	September 29, 2003) Examiner: S. Ip
)
For:	METAL ALLOYS FORMING)
	PASSIVATING CONDUCTIVE)
	OXIDES FOR DURABLE ELEC-)
	TRICAL CONTACT SURFACES)

Mail Stop: Amendment

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is Applicants' response to the Office Action dated March 24, 2006 requiring restriction between claims 1-15 (group I), claims 16-18 (group II), and claims 19-24 (group III). In response, Applicants provisionally elect to prosecute claims 1-15 (group I), and respectfully traverse the requirement for restriction.

The Office Action argues that the three groups of claims are allegedly related as products that share "a common utility of using a metal alloy" where the common utility is not linked to a substantial structural feature, and further asserts that products in this relationship are distinct if the products encompass embodiments that are not required to perform the common utility or that the products as claimed can be used to perform another utility. Applicants attorney has diligently

searched the Manual of Patent Examining Procedure and can find no support for this line of analysis to determine distinctness. Applicants respectfully request that the Examiner provide some supporting basis for the asserted standard for determining distinctness so that it can be better understood.

Applicants require such support in order to effectively respond to the Restriction Requirement because the way it has been applied does not seem to make sense. The Examiner asserts that the claims are products that have a common utility of using a metal alloy, but claims 1-15 are clearly not directed to a product that uses a metal alloy. Rather, they are directed to the metal alloy *itself* as a *composition of matter*. The Examiner argues that the products as claimed can be used to perform “another utility, such as solders”, but if the common utility is really “using a metal alloy” as asserted in the Office Action, how can using the metal alloy of claims 1-15 in a solder be a different utility than the utility of claims 1-15 since it is still “using a metal alloy (as a solder)”. However, rather than focus on the inconsistencies raised by the Office Action’s improper characterization of the relationship between the claims, Applicants submit that it would be more helpful to focus on how the claims are properly related in an analysis to determine distinctness.


The claims of groups I, II, and III are properly related as subcombination and combination. As stated in the MPEP § 806.05(a), “a combination is an organization of which a subcombination or element is a part”. In the present application, claims 1-15 are directed to a subcombination of a metal alloy, claims 16-18 are directed to a combination of that metal alloy in an electrical contact, and claims 19-24 are directed to a combination of that electrical contact in an electromechanical apparatus. As set forth in MPEP § 806.05(c), claims in subcombination/combination relationship are distinct only if both: (1) the combination does not require the particulars of the subcombination for patentability, *and* (2) the subcombination can be shown to have utility by itself or in a materially different combination. In the present case, the combination claims clearly *do* require the particulars of the subcombination metal alloy for patentability since without those particulars, they would simply cover a generic electrical contact and a generic electromechanical apparatus, which are already known in the art.

In view of the above, Applicants respectfully submit that the requirement for restriction is improper and should be withdrawn.

DP-309451

If there are any additional charges with respect to this amendment or otherwise, please charge them to Deposit Account No. 50-0831.

Respectfully submitted,

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